REMARKS/ARGUMENTS

Claims 1-20 are pending in the present application. Claims 1, 4, 6-8, 10, 13, 14, 16, 19, and 20 are amended. Support for the claim amendments can be found in the claims as originally filed. Reconsideration of the claims is respectfully requested.

I.   **35 U.S.C. § 103, Obviousness: Claims 1, 3, 5, 13, 15, and 17**

The Examiner rejected claims 1, 3, 5, 13, 15, and 17 under 35 U.S.C. § 103 as obvious over Applicant's Admitted Prior Art (hereinafter "*AAPA*") in view of *Peters et al.*, Managing Host to Workstation File Transfer, U.S. Patent 4,999,766, March 12, 1991 (hereinafter "*Peters*"). The rejection is respectfully traversed. With respect to amended claim 1, the Examiner states that:

> As per claims 1 and 13, *AAPA* teaches a storage network system and a method, comprising:
>   a storage system (e.g. disk subsystem) (Specification, page 2, 11. 9-1 0);
>   a storage controller (e.g. disk/RAID controller), wherein the storage controller provides access to the storage system (storage system comprising of two or more hard disks) (Specification, page 2, 11. 10-1 2) and wherein the storage controller has a serial port for connection to an external device (e.g. laptop computer or maintenance device) (Specification, page 2,11. 14-1 5); and
>   the external device, electrically coupled to the storage controller through the serial port (Specification, page 2, 11. 14-15), and a user initializing the serial port by selecting at least one serial port parameter value (e.g. baud rate) for a set of serial port parameters (e.g. baud rate, data bits, stop bits, parity and flow control) (Specification, page 2, 1. 16 to page 3, 1. 1).
>   *AAPA* does not teach the storage network system and the method for serial port initialization, comprising: receiving at least one serial port parameter value and initializing the serial port by using the received serial port parameter value selected by the user.
>   *Peters* teaches a system and a method comprising:
>   providing a communication initialization menu to a user and the user selecting (e.g. selecting by typing and overriding) a specific communication parameter and initializing a communication line with the selected specific communication parameter (col. 1, 1. 66 to col. 2, 1. 13), wherein after receiving the specific communication parameter, the communication line and the corresponding ports would obviously operate accordingly.
>   *Peters* is analogous art because as *Peters'* communication initialization menu is reasonably pertinent to the particular problem with which the applicant was concerned, which is to enable a user to initialize a communication link with a peripheral.
>   It would have been obvious to one of ordinary skill in this art, at the time of invention was made to include *Peters'* communication initialization menu into *AAPA's* storage network system. The resulting combination of the references further teaches the storage network system and the method for serial port initialization, comprising:
>   providing the communication initialization menu to the user, and the user selecting at least one serial port parameter value; and

after receiving the selected at least one serial port parameter value, the communication with the corresponding serial port would be initialized accordingly.

The suggestion/motivation for doing so would have been for the benefit of relieving the user of the burden of remembering all of the parameters for initializing a communication session (*Peters*, col. 2, 11. 4-6).

Therefore, it would have been obvious to combine *Peters* with *AAPA* for the benefit of relieving the user of the burden of remembering all of the parameters for initializing a communication session to obtain the invention as specified in claims 1 and 13.

Office Action dated May 29, 2007, pages 8-10.

Amended claim 1, which is representative of amended claim 13, is as follows:

1.   A method for serial port initialization in a storage controller, wherein the storage controller includes a serial port for connection to an external device, the method comprising:

receiving at least one serial port parameter value for a set of serial port parameters, wherein the at least one serial port parameter value is selected by a user; and

initializing the serial port on the storage controller using the at least one serial port parameter value.

No *prima facie* obviousness rejection can be made against amended claim 1 because neither *AAPA* nor *Peters* teach or suggest all of the claimed features of amended claim 1. Further, no proper reason exists to combine the references to achieve the invention of amended claim 1. Additionally, both *AAPA* and *Peters* teach away from amended claim 1.

I.A.   *AAPA* and *Peters* Fail to Teach or Suggest All of the Features of Amended Claim 1

No *prima facie* obviousness rejection can be stated because none of the references, alone or in combination, teach or suggest all of the features of amended claim 1. The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Additionally, all limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Therefore, the Examiner fails to state a *prima facie* obviousness rejection if the proposed combination does not teach all of the features of the claimed invention.

Specifically, *AAPA* and *Peters*, together or individually, fail to teach or suggest the feature of initializing the serial port on the storage controller using the at least one serial port parameter value. The Examiner cites a portion of *Peters* with respect to the feature of "initializing a serial port on the storage controller using the received serial port parameter values," as recited in previously presented claim 1. However, *Peters* fails to teach or suggest the feature of "initializing the serial port on the storage

controller using the at least one serial port parameter value," as recited in amended claim 1. Specifically, the Examiner cites the following portion of *Peters*:

> The Smartcom II product from Hayes Microcomputer Products provides a communication initialization menu that defaults all the parameters of a communications line to specific values based on common parameters used by many users. The parameters can be overridden by the user by typing over the entry. This technique relieves the user of the burden of remembering all of the parameters commonly used to support a communications session. The parameters are not coordinated with the particular workstation or host computer with which the user is trying to communicate. Therefore, the user must have enough familiarity with the communications environment to override the default parameters with the correct parameters, such as baud rate, parity, stop bits and so forth, that correspond with the particular device with which communications is to be established.

Peters, column 1, lines 66 – column 2, line 13.

Neither the cited portion nor any other portion of *Peters* teaches or suggests the feature of initializing the serial port on the storage controller using the at least one serial port parameter value. *Peters* discloses a technique for maintaining consistent filename conventions between multiple hosts and workstations. Specifically, *Peters* provides a table of default parameters for various hosts and workstations and the corresponding file types that are accessed to determine the default parameters and file types for a given file. The cited portion, taken from the Background of the Invention section of *Peters*, describes the Smartcom II product from Hayes Microcomputer Products. The cited portion discloses that the Smartcom II product provides a communication initialization menu that includes default values for communications line parameters. However, the cited portion nowhere mentions serial ports, let alone that the Smartcom II product initializes serial ports.

On the other hand, amended claim 1 recites the feature of "initializing the serial port on the storage controller using the at least one serial port parameter value." As a first matter, the cited portion differs from the claimed feature because the cited portion discloses only that the Smartcom II products initializes a "communications line," but nowhere teaches or suggests the type of communication line that the Smartcom II product initializes, let alone a serial port, as claimed.

For example, the cited portion states that "[t]he Smartcom II product from Hayes Microcomputer Products provides a communication initialization menu that defaults all the parameters of a communications line to specific values based on common parameters used by many users." However, the cited statement discloses only defaulting parameters of a communications line, but nowhere teaches or suggests that the communication line is a serial port. Many different types of communication lines may be implemented in computer hardware, such as parallel ports, ATA, ATA/IDE, SCSI, parallel SCSI, USB, IEEE-1394, Firewire, Ethernet, and Fibre Channel. The cited statement nowhere discloses which of these types of communications lines is manipulated using the communication initialization menu, and

nowhere mentions serial ports. Thus, the cited portion fails to teach or suggest the feature of initializing the serial port on the storage controller using the at least one serial port parameter value.

As a second matter, even assuming, *arguendo*, that the cited portion teaches or suggests initializing the serial port on the storage controller, the cited portion still fails to teach or suggest the feature of initializing the serial port on the storage controller using the at least one serial port parameter value. Specifically, the cited portion differs from the claimed feature because the cited portion nowhere mentions that the defaulted parameters values for the communication line are serial port parameters values.

For example, the cited portion states that "the user must have enough familiarity with the communications environment to override the default parameters with the correct parameters, such as baud rate, parity, stop bits and so forth, that correspond with the particular device with which communications is to be established." However, the cited statement discloses only generic parameters that may be used for any type of communication line, but nowhere discloses that the parameters are serial port parameter values. Hence, *Peters* fails to teach or suggest the feature of initializing the serial port on the storage controller using the at least one serial port parameter value.

The Examiner relies on *AAPA* to describe serial ports. The Examiner relies on *Peters* to initialize the claimed serial port in the claimed manner. However, as shown above, *Peters* provides no disclosure that actually would allow one to initialize the claimed serial port. Therefore, when the references are considered as a whole, the combination of *Peters* and *AAPA* does not teach or suggest "initializing the serial port on the storage controller using the at least one serial port parameter value," as recited in amended claim 1. Accordingly, the proposed combination of *Peters* and *AAPA*, when considered as a whole, does not teach or suggest all of the features of amended claim 1. For this reason, the Examiner has failed to state a *prima facie* obviousness rejection against amended claim 1.

I.B.   The Examiner Failed to State a Sufficient Reason to Combine the References

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed

by the patent at issue. *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

In the case at hand, no *prima facie* obviousness rejection can be stated because the Examiner failed to state a sufficient reason to combine *AAPA* and *Peters* in light of the differences between the cited references and amended claim 1. Specifically, as shown in Section I.A., neither *AAPA* nor *Peters* teach or suggest the feature of initializing the serial port on the storage controller using the at least one serial port parameter value. Because neither *AAPA* nor *Peters* teach or suggest at least this claimed feature, major differences exist between the cited references and amended claim 1 under the *Graham v. John Deere Co.* inquiry set forth above.

Furthermore, the Examiner failed to state a sufficient reason to combine *AAPA* and *Peters* in light of the differences that exist between the cited references and amended claim 1. The Examiner failed to state a sufficient reason to combine *AAPA* and *Peters* because the Examiner's proposed reason for combining *AAPA* and *Peters* provides no rational underpinning to support a legal conclusion of obviousness. Regarding a reason to combine *AAPA* and *Peters*, the Examiner states that:

> The suggestion/motivation for doing so would have been for the benefit of relieving the user of the burden of remembering all of the parameters for initializing a communication session (*Peters*, col. 2, 11. 4-6).
>
> Therefore, it would have been obvious to combine *Peters* with *AAPA* for the benefit of relieving the user of the burden of remembering all of the parameters for initializing a communication session to obtain the invention as specified in claims 1 and 13.

Office Action dated May 29, 2007, pages 9 and 10.

The Examiner offers an advantage as the stated reason for combining *AAPA* and *Peters* in the manner proposed by the Examiner. Specifically, the Examiner proposes combining *AAPA* and *Peters* "for the benefit of relieving the user of the burden of remembering all of the parameters for initializing a communication session." However, the Examiner fails to provide a sufficient reason to combine *AAPA* and *Peters* because *AAPA* already achieves the advantage set forth by the Examiner. Specifically, *AAPA* discloses that controllers typically support only setting the baud rate parameter, as shown in the following portion of *AAPA*:

> RAID controller typically include a serial port for communication with an external device, such as a laptop computer or other maintenance device. An operator may connect an external device to the serial port of a RAID controller for maintenance, monitoring, or configuration. Both the controller and the external device have serial port parameter settings, such as, for example, baud rate, data bits, stop bits, parity, and flow control. The parameter settings must be synchronized for communication between the device and the controller to be

effective. <u>The controller typically only supports setting the baud rate of the serial port and no other parameter settings.</u>

Applicant's specification, page 2, lines 14-21 (emphasis added).

Because *AAPA* discloses that controllers typically only support setting a baud rate, *AAPA* achieves the advantage of "relieving the user of the burden of remembering all of the parameters for initializing a communication session." Specifically, *AAPA* achieves this advantage by supporting the setting of only one parameter, the baud rate, thereby relieving the user from having to "remember[] all of the parameters." Because *AAPA* already achieves the advantage offered by the Examiner as a reason to combine *AAPA* with *Peters*, the cited advantage cannot provide a rational underpinning to support a legal conclusion of obviousness. For this reason, the Examiner's reason for combining *AAPA* and *Peters* provides insufficient basis for combining *AAPA* and *Peters* in the manner proposed by the Examiner, especially in light of the major differences that exist between the cited references and amended claim 1. Accordingly, no *prima facie* obviousness rejection has been stated against amended claim 1.

I.C.   Both *AAPA* and *Peters* Teach Away from Amended Claim 1

A reference may be said to "teach away" from the claimed invention when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2D 1130, 1131 (Fed. Cir. 1995). If a reference teaches away from the claimed invention, then no proper reason exists to combine the references under the standards of *KSR, Int'l*. In this case, *AAPA* and *Peters* both teach away from amended claim 1.

The Examiner relies on *AAPA* as teaching the claimed feature of, "wherein the at least one serial port parameter is selected by a user." The Examiner cites the following portion of *AAPA* as teaching this claimed feature:

> RAID controller typically include a serial port for communication with an external device, such as a laptop computer or other maintenance device. An operator may connect an external device to the serial port of a RAID controller for maintenance, monitoring, or configuration. Both the controller and the external device have serial port parameter settings, such as, for example, baud rate, data bits, stop bits, parity, and flow control. The parameter settings must be synchronized for communication between the device and the controller to be effective. The controller typically only supports setting the baud rate of the serial port and no other parameter settings.
> However, several problems exist for controllers with serial port communication. There are currently no default serial port parameters set for a controller's serial port during boot code initialization. When the controller downloads non-volatile static random access memory (NVSRAM) code, the controller may not be responsive for serial port communication. Also, the controller may not be responsive for serial port communication after swapping

one of the controllers with a foreign controller and auto-code synchronization (ACS) has been completed.

Serial port initialization on RAID controllers poses many problems as port parameters are typically set by invoking a <BREAK> key sequence on the serial console. By repeating the break sequence, a user may cycle through baud rate values for the serial port. However, the user may not know how many times the break sequence was invoked and, thus, may not know what baud rate is set. The user may also miss the intended value and must restart the break key sequence. This solution for setting serial port parameters is non-intuitive and potentially frustrating.

Applicant's specification, page 2, line 14 – page 3, line5.

These paragraphs describe one of the problems associated with the user setting the serial port parameter. One example provided above states that the user does not know how many times a break sequence was involved in setting the serial port parameter and that the solution for setting serial port parameters is <u>non-intuitive and potentially frustrating</u>.

Thus, one of ordinary skill would <u>avoid</u> having the user set the at least one serial port parameter in order to avoid the stated problem. Thus, the Examiner's reliance on *AAPA* as teaching the claimed feature of, "wherein the at least one serial port parameter is selected by a user" is entirely misplaced. Instead, *AAPA* specifically teaches against the claimed invention. For this reason, *AAPA* teaches away from amended claim 1. Accordingly, the Examiner has not established a proper reason to combine the references and the Examiner has not established a *prima facie* obviousness rejection against claim 1.

Additionally, *Peters* also directly teaches away from the invention of amended claim 1. *Peters* provides a table of default parameters for various hosts and workstations and the corresponding file types that are accessed to determine the default parameters and file types for a given file. *Peters*, column 2, lines 60-64. *Peters'* explicit objective for providing the table of default parameters is to "<u>relieve the user of the burden of explicitly defining each of the parameters</u> associated with a particular record." *Peters*, column 2, lines 56-59. In stark contrast, amended claim 1 explicitly provides that "the at least one serial port parameter value <u>is selected by a user</u>." Thus, amended claim 1 claims that a serial port parameter value <u>is selected by a user</u>, while *Peters* teaches <u>eliminating an explicit selection</u> by a user for each of the parameters.

For these reason, both *AAPA* and *Peters* teach away from the invention of amended claim 1. Accordingly, no proper reason exists to combine the references; indeed, a strong motivation exists to avoid combining the references to achieve the claimed invention because no possible combination could result in the claimed invention. Therefore, the Examiner has failed to state a *prima facie* obviousness rejection against amended claim 1.

I.D.   Conclusion as to Obviousness.

Because amended claim 1 is representative of amended claim 13, the same distinctions between amended claim 1 and the references apply to amended claim 13. Further, the references may not be combined in the manner proposed by the Examiner in order to achieve the inventions of amended claims 1 and 13. Accordingly, no *prima facie* obviousness rejection can be made against amended claims 1 and 13. Therefore, the Examiner cannot state a *prima facie* obviousness rejection against claims 3, 5, 15, and 17, at least by virtue of their dependency on amended claims 1 and 13. Consequently, Applicants have overcome the obviousness rejection of claims 1, 3, 5, 13, 15, and 17 under 35 U.S.C. § 103.

II.   35 U.S.C. § 103, Obviousness: Claims 2 and 14

The Examiner rejected claims 2 and 14 under 35 U.S.C. § 103 as obvious over *AAPA* in view of *Peters*, and further in view of *Farrand et al.,* Graphical User Interface for Computer Management System and an Associated Management Information Base, U.S. Patent 5,559,958, September 24, 1996 (hereinafter "*Farrand*"). This rejection is respectfully traversed. The Examiner states that:

> *AAPA* and *Peters* teach all the limitation of claims 1 and 13 as discussed above, wherein *Peters* further teaches presenting a boot menu (e.g. the communication initialization menu) to the user, wherein the boot menu enable the user to select the setting of a plurality of communication parameters (*Peters*, col. 1, 1. 66 to col. 2, 1. 13), but *AAPA* and *Peters* does not teach the storage network system and method, comprising:
> wherein the boot menu includes an option for enabling a serial console mode;
> receiving a first user selection to enable the serial console mode;
> presenting the serial console mode menu to the user; and
> receiving a second user selection of comprising at least one serial port parameter value, wherein the second user selection is made using the serial console mode menu.
> *Farrand* teaches a graphic user interface (GUI) for computer management system and method comprising:
> displaying to a user a file server menu, wherein the file server menu includes a engineering server subsystem (Fig. 10);
> receiving a user selection of the engineering server subsystem (Fig. 10-11);
> presenting the engineering server subsystem (Fig. 11);
> receiving the user selectively depressing one of the engineering server subsystem button comprising a configuration subsystem button (Fig. 11, ref. 516), an input/output subsystem button (Fig. 11, ref. 528), a disk storage subsystem button (Fig. 21 11, ref. 520) and a security configuration subsystem button (Fig. 11, ref. 518) (Fig. 11 and col. 197, 11. 1-14).
> *Farrand* is analogous art because *Farrand* is in the field of applicant's endeavor which is the communication between the disk storage system and the computer for managing by configuring the disk storage system.
> It would have been obvious to one of ordinary skill in this art, at the time of invention was made to include *Farrand's* GUI menu into *AAPA* and *Peters'*

storage network system and method. The resulting combination of the references teaches the storage network system and method further comprising:

displaying to the user the communication initialization menu, wherein the communication initialization menu would obviously include the option for selection one of the plurality of communication parameters (e.g. baud rate);

receiving the first user selection to enable the menu for setting one of the plurality of communication parameters;

presenting the menu for one of the plurality of communication parameters (e.g. baud rate) to the user; and

receiving the second user selection of comprising the corresponding communication parameter value (e.g. entering the value for the baud rate), wherein the second user selection is made using the menu for one of the plurality of communication parameters.

The suggestion/motivation for doing so would have been for the benefit of providing a GUI interface which enable the user/operator to easily select the available options/functions rather than requiring complex typing of commands to implement the desire functionalities.

Therefore, it would have been obvious to combine *Farrand* with *AAPA* and *Peters* for the benefit of providing a GUI interface which enable the user/operator to easily select the available options/functions rather than requiring complex typing of commands to implement the desire functionalities to obtain the invention as specified in claims 2 and 14.

Office Action dated May 29, 2007, pages 11-13.

Claim 2, which is representative of claim 14, is as follows:

2.   The method of claim 1, wherein receiving at least one serial port parameter value includes:

presenting a boot menu to the user, wherein the boot menu includes an option for enabling a serial console mode menu;

receiving a first user selection to enable the serial console mode menu;

presenting the serial console mode menu to the user; and

receiving a second user selection comprising at least one serial port parameter value, wherein the second user selection is made using the serial console mode menu.

As an initial matter, the rejection of claims 2 and 14 relies on the false premise that *AAPA* and *Peters* teach or suggest the features of amended claim 1. However, as shown in Section I.A., *AAPA* and *Peters* fail to teach or suggest the feature of initializing the serial port on the storage controller using the at least one serial port parameter value.

In addition, *Farrand* teaches none of the features of amended claim 1 and 13, and the Examiner does not assert otherwise. *Farrand* instead discloses a computer management system having plural instrumentation agents for querying manageable devices to collect object data, an associated enterprise management information base for storing the object data, and a graphical user interface for managing the manageable devices using the enterprise management information base. Accordingly, the proposed combination of *AAPA*, *Peters*, and *Farrand*, when considered together as a whole, does not teach or

suggest all of the features of amended claims 1 and 13. Therefore, the Examiner has failed to state a *prima facie* obviousness rejection against claims 2 and 14, which depend from amended claims 1 and 13.

Also, because the Examiner attempts to combine *AAPA* and *Peters* to reject claims 2 and 14, and because claims 2 and 14 depend from amended claim 1 and 13, the same analysis applied in Section II regarding the improper combination of *AAPA* and *Peters* also applies to claims 2 and 14. Specifically, no proper reason exists to combine *AAPA* and *Peters* to achieve the invention of amended claim 1. Additionally, both *AAPA* and *Peters* teach away from amended claim 1. Accordingly, no *prima facie* obviousness rejection can be made against claims 2 and 14, against which the Examiner attempts to combine *AAPA* and *Peters*.

Additionally, no *prima facie* obviousness rejection can be made against claims 2 and 14 because *AAPA*, *Peters*, and *Farrand* fail to teach or suggest all of the claimed features of claims 2 and 14. Further, *Farrand* is non-analogous art and renders *Peters* unsatisfactory for *Peters*' intended result.

II.A.   *AAPA*, *Peters*, and *Farrand* Fail to Teach or Suggest All of the Features of Claims 2 and 14

Additionally, the Examiner has failed to state a *prima facie* obviousness rejection because the proposed combination of references, when considered as a whole, does not teach or suggest all of the features of claim 2, which is representative of claim 14. For example, *AAPA*, *Peters*, and *Farrand* fail to teach or suggest the feature of "receiving a second user selection comprising at least one serial port parameter value, wherein the second user selection is made using the serial console mode menu," as claimed in claim 2. The Examiner asserts otherwise, citing various portions of *Farrand*. Applicants now address each of these portions of *Farrand* to show that *Farrand* fails to teach or suggest the claimed feature. The Examiner first cites reference numerals 516, 518, 520, and 528 of the following figure of *Farrand*, along with the portion of *Farrand* that describes the cited figure:
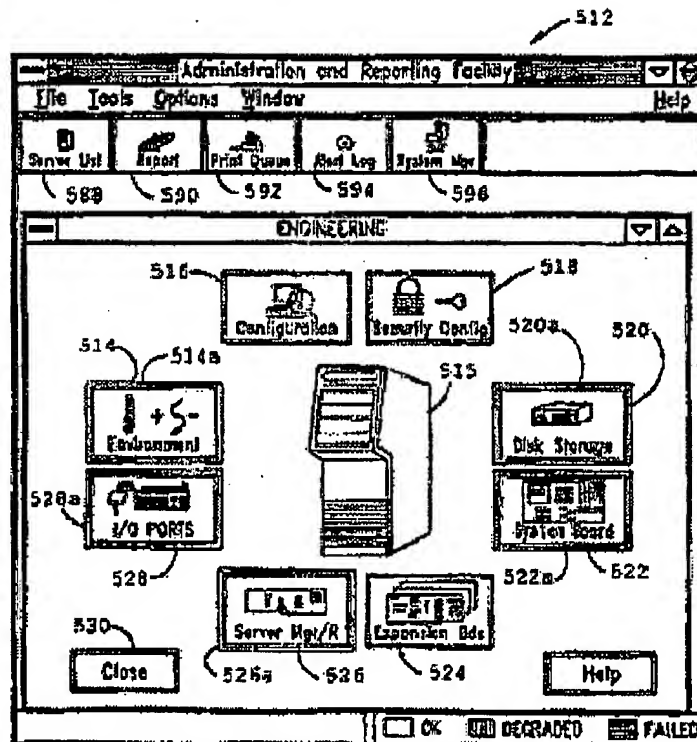
FIG. 11

Farrand, Figure 11.

Returning to step 206, if the network administrator decides to view the highlighted server, the network administrator selects the view button 504. Proceeding to step 212, the management application 16 generates a selected server GUI 512 from which the selected file server may be managed. As may be seen in FIG. 11, the selected server GUI 512 identifies the detailed management information which may be viewed for the selected file server. The selected server GUI 512 includes an image 515 of the selected file server, in the illustrated example, a Systempro file server manufactured by Compaq Computer Corporation of Houston, Tex., surrounded by a plurality of buttons, each of which corresponds to one of plural file server subsystems for which management information regarding the selected file server is accessible for viewing. Buttons provided in the selected server GUI 512 include an environment subsystem button 514, a configuration subsystem button 516, a security configuration subsystem button 518, a disk storage subsystem button 520, a system board subsystem button 522, an expansion boards subsystem button 524, a server manager subsystem button 526 and an input/output (or "I/O") ports subsystem button 528. By selectively depressing one of subsystem buttons 516, 518, 520, 522, 524, 526 or 528, a GUI through which management information for the selected subsystem is available will be displayed.

Farrand, column 196, line 57 – column 197, line 14.

Neither the cited portions nor any other portion of *Farrand* teaches or suggests the feature of, "receiving a second user selection comprising at least one serial port parameter value, wherein the second user selection is made using the serial console mode menu." The cited figure depicts a graphical user interface for a selected server that identifies detailed management information that may be viewed for the selected file server. Specifically, the cited portions disclose multiple buttons for a selected file server. Each of the buttons correspond to one of a plurality of file server subsystems for which management information regarding the selected file server is accessible for viewing. However, none of the buttons, including buttons 516, 518, 520, and 528, in the graphical user interface are selectable serial port parameter values, as claimed.

On the other hand, claim 2 recites the feature of receiving a second user selection comprising at least one serial port parameter value, wherein the second user selection is made using the serial console mode menu. The cited portion differs from the claimed feature because the cited portion fails to mention serial ports at all, and therefore does not disclose a user selection of at least one serial port parameter value. Further, the cited portion nowhere discloses that buttons 516, 518, 520, and 528 relate to serial ports. Hence, none of the buttons illustrated in Figure 11 are the same as serial port parameter values, as claimed.

For example, the cited portion states that "[b]uttons provided in the selected server GUI 512 include an environment subsystem button 514, a configuration subsystem button 516, a security configuration subsystem button 518, a disk storage subsystem button 520, a system board subsystem button 522, an expansion boards subsystem button 524, a server manager subsystem button 526 and an input/output (or "I/O") ports subsystem button 528." However, the cited statement discloses only the different buttons that may be selected for viewing different subsystems for a particular file server. However, the cited statement nowhere mentions serial ports, let alone teaches or suggests that one of the buttons in selected server GUI 512 is a serial port parameter value, as claimed. Therefore, *Farrand* fails to teach or suggest the feature of receiving a second user selection comprising at least one serial port parameter value, wherein the second user selection is made using the serial console mode menu.

AAPA and *Peters* fail to cure *Farrand's* lack of disclosure. The Examiner admits that "*AAPA* and *Peters* does not teach the storage network system and method, comprising ... receiving a second user selection of comprising at least one serial port parameter value, wherein the second user selection is made using the serial console mode menu." Office Action dated May 29, 2007, page 11. Furthermore, neither *AAPA* nor *Peters* suggest any of the features of claim 2. Hence, the proposed combination of *AAPA*, *Peters*, and *Farrand*, when considered as a whole, does not teach or suggest all of the features of claim 2. Because claim 2 is representative of claim 14, the proposed combination of *AAPA*, *Peters*, and *Farrand*, when considered as a whole, does not teach or suggest all of the features of claim 14.

II.B.   The Proposed Combination Renders *Peters* Unsatisfactory for *Peters'* Intended Purpose

The Examiner has failed to state a *prima facie* obviousness rejection because the proposed combination renders *Peters* unsatisfactory for *Peters'* intended purpose. "If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

An intended purpose of *Peters* is to "relieve the user of the burden of explicitly defining each of the parameters associated with a particular record." *Peters*, column 2, lines 57-59. *Peters* achieves this intended purpose by providing a table of default parameters for various hosts and workstations and the corresponding file types that are accessed to determine the default parameters and file types for a given file. *Peters*, column 2, lines 60-64. For example, *Peters* provides as follows:

> It is a further object of the invention to provide a semi-intelligent file transfer option preselection which <u>relieves the user of the burden of explicitly defining each of the parameters associated with a particular record.</u>
> According to the invention, these objects are accomplished by providing a table of default parameters for various hosts and workstations and the corresponding file types that are accessed to determine the default parameters and file types for a given file. A set of screens are also provided to obtain the name or names of files to be transferred and to where the files are to be transferred. The programs which produce these screens also obtain and display default information concerning the files, such as, the file names and the data structures in which the files will reside at the destination host computer or workstation. The user can either accept the default information or change it.

Peters, column 2, lines 55-68 (emphasis added).

In another example, *Peters*, in the Field of the Invention section, provides as follows:

> This invention generally relates to file transfers between a workstation and a host computer and, more particularly, to the maintenance of consistent filename conventions between multiple hosts and intelligent workstations. Files are received from and sent to the host computer by workstations. An additional feature is the use of default file transfer options based on the file name which <u>relieves the user from explicitly defining each of the parameters associated with a particular file.</u>

Peters, column 1, lines 7-15.

Thus, an intended purpose of *Peters* is to relieve the user of the burden of explicitly defining each of the parameters associated with a particular file. Defining parameters in any way that detracts from this intended purpose, such as by providing a graphical user interface that requires a user to select parameters, would defeat the entire purpose of *Peters*.

The Examiner proposed combination renders *Peters* unsatisfactory for *Peters'* intended purpose because *Farrand*, instead of providing a table of default parameters, requires the user to select parameters from a graphical user interface. For example, *Farrand* provides as follows:

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Returning to step 206, if the network administrator decides to view the highlighted server, the network administrator selects the view button 504. Proceeding to step 212, the management application 16 generates a selected server GUI 512 from which the selected file server may be managed. As may be seen in FIG. 11, the selected server GUI 512 identifies the detailed management information which may be viewed for the selected file server. The selected server GUI 512 includes an image 515 of the selected file server, in the illustrated example, a Systempro file server manufactured by Compaq Computer Corporation of Houston, Tex., surrounded by a plurality of buttons, each of which corresponds to one of plural file server subsystems for which management information regarding the selected file server is accessible for viewing. Buttons provided in the selected server GUI 512 include an environment subsystem button 514, a configuration subsystem button 516, a security configuration subsystem button 518, a disk storage subsystem button 520, a system board subsystem button 522, an expansion boards subsystem button 524, a server manager subsystem button 526 and an input/output (or "I/O") ports subsystem button 528. By selectively depressing one of subsystem buttons 516, 518, 520, 522, 524, 526 or 528, a GUI through which management information for the selected subsystem is available will be displayed.

Farrand, column 196, line 57 – column 197, line 14.

The Examiner also recognizes that *Farrand* "provid[es] a GUI interface which enable the user/operator to easily select the available options/functions rather than requiring complex typing of commands to implement the desire functionalities." Office Action dated May 29, 2007, page 13. Hence, because *Farrand* includes a graphical user interface that requires a user to select options, functions, and other parameters, while *Peters'* intended purpose is to relieve the user of the burden of explicitly defining parameters, *Farrand's* teaching of a graphical user interface renders *Peters* unsatisfactory for *Peters'* intended purpose. Therefore, no *prima facie* obviousness rejection has been made against the rejected claims.

II.C.   *Farrand* Is Non-Analogous Art

The Examiner has failed to state a *prima facie* obviousness rejection because *Farrand* is non-analogous art. In order to rely on a *Farrand* as a basis for rejection, *Farrand* must be either in the Applicant's field of endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992); *In re Deminski*, 796 F.2d 436, 442, 230 U.S.P.Q. 313, 315 (Fed. Cir. 1986).

In the case at hand, *Farrand* is not in the same field of endeavor of claims 2 and 14 and *Farrand* is not reasonably pertinent to the particular problem with which Applicants were concerned. With regard to the first part of the test for analogous art, *Farrand* is not in the same field of endeavor of claims 2 and 14 because *Farrand* is in the field of managing information bases. In contrast, claims 2 and 14 are in the field of setting serial port parameters. The two fields are wholly distinct from each other because

managing information bases has utterly nothing to do with setting serial port parameters in a serial port. Thus, *Farrand* fails the first test of *In re Oetiker*.

With regard to the second part of the test for analogous art, *Farrand* is not reasonably pertinent to the particular problem with which Applicants were concerned. As established above, *Farrand* is in the field of managing information bases. Specifically, *Farrand* is directed to the problem of managing information bases through the use of graphical user interfaces. For example, *Farrand* provides that:

> The invention relates to a computer management system and, more particularly, to a computer management system having plural instrumentation agents for querying manageable devices to collect object data, an associated enterprise management information base (or "MIB") for storing object data in accordance with a specified MIB architecture and a graphical user interface (or "GUI") for managing the manageable devices using the enterprise MIB.

Farrand, column 1, lines 52-59.

In contrast, claims 2 and 14 are directed to the problem of serial port initialization. The problem addressed by *Farrand* is wholly distinct from the problem addressed by claims 2 and 14. For this reason, *Farrand* is not reasonably pertinent to the particular problem with which Applicants were concerned. Therefore, *Farrand* fails the second part of the *In re Oetiker* test for analogous art.

As established above, *Farrand* fails both tests for analogous art set forth by *In re Oetiker*. Therefore, *Farrand* is non-analogous art. For this reason, the Examiner can not use *Farrand* when fashioning an obviousness rejection against claims 2 and 14. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claims 2 and 14.

II.D.   Rebuttal to the Examiner's First Response

In response to the above facts, the Examiner states that:

> In responding to applicant's argument regarding independent claim 2 rejected under 35 U.S.C. 103(a) that the propose combination of *AAPA*, *Wood* and *Farrand* does not teach all the features of the claims, because *Farrand* does not teach or suggest initialization of a serial port using a GUI or any other method, as stated on page 18, 1ᵗ paragraph. Applicant's arguments have fully been considered, but are found not to be persuasive.
> As the examiner discussed in detail above, *AAPA* and *Wood* does teach the initialization of a serial port. *Farrand* further teaches the utilizing of GUI (i.e. subsystem configuration button) for the purpose of implementing configuration, as all the buttons are associated with various configurations (*Farrand*, Fig. 11, ref. 516, 51 8, 520, 528). Therefore, by combining *Farrand* with *AAPA* and *Wood* the resulting combination teaches utilizing the GUI for the purpose of implementing configuration associated with the initialization of the serial port.

Final Office Action dated December 6, 2006, pp. 11-12.

Although the Examiner no longer cites *Wood* against claims 2 and 14, Applicant's address the portion of the Examiner's rebuttal that relates to *Farrand*, which is still used to reject claims 2 and 14. Regarding *Farrand*, the Examiner is attempting to show some general teaching regarding the existence of graphical user interfaces to teach the specific claimed features of claims 2 and 14. Claim 2 recites, "receiving a second user selection comprising at least one serial port parameter value, wherein the second user selection is made using the serial console mode menu." These features are specific to serial ports. *Farrand* is utterly devoid of disclosure with regard to initialization of serial ports and is further utterly devoid of disclosure with regard to graphical user interfaces with respect to initialization of serial ports. The Examiner may not rely on a graphical user interface "for implementing configuration." Instead, the Examiner must show how *Farrand* teaches the specific features of claims 2 and 14 that the Examiner admits are not in *Peters* and *AAPA*. The Examiner has not done so. Therefore, the Examiner fails to state a *prima facie* obviousness rejection against claims 2 and 14.

II.E.   Rebuttal to the Examiner's Second Response

In response to the above facts, the Examiner also states that:

> In responding to applicant's argument regarding independent claim 2 rejected under 35 U.S.C. 103(a) applicant appears to argue that *AAPA*, *Wood* and *Farrand* are non-analogous art, as applicant cited *In re Oetiker*, and further emphasized that *Farrand* solves a different problem than *AAPA* and *Wood*, as stated on page 18, 2nd paragraph. Applicant's arguments have fully been considered, but are found not to be persuasive.
> Please note that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, *Farrand's* GUI is implemented on a computer (e.g. management station/counsel) coupled to a plurality of disk storage system for configuring the plurality of disk storage system, where as, *AAPA* and *Wood* teaches a host computer coupled to a plurality of disk drives (e.g. disk storage system) for initializing (configuring) the serial port.

Final Office Action dated December 6, 2006, p. 12.

In light of the requirements of *In re Oetiker*, the Examiner's characterizations of *Farrand* and claims 2 and 14 are too broad to establish that *Farrand* is in the same field of endeavor as claims 2 and 14. For example, the court in *In re Oetiker* stated that:

> The examiner stated that "since garments commonly use hooks for securement", a person faced with the problem of unreliable maintenance of the pre-assembly configuration of an assembly line metal hose clamp would look to the garment industry art.

In re Oetiker, 977 F.2d 1443 at 1446.

The Examiner in *In re Oetiker* attempted to use substantially the same argument as the present Examiner. The argument is as follows: Because *Farrand* and the claim both deal with the same broad class of problem, *Farrand* is in the same field of endeavor as the claimed invention. However, the Court of Appeal for the Federal Circuit specifically states that this argument is incorrect:

> It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from nonanalogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.

Id. at 1447 (emphasis added).

The court ruled that the Examiner failed to show that a person of ordinary skill solving a problem of fastening hose clamps would reasonably be expected or motivated to look to another reference dealing with fasteners for garments. Even though both technologies are in the same broad field of fastening objects, the reference was still considered to be non-analogous art.

In the case at hand, *Farrand* is directed to the field of management information bases. In contrast, claims 2 and 14 are directed to the field of serial port initialization. These fields are more distinct from each other than the field of hose clamps and the field of fasteners for garments. Therefore, under the standards of *In re Oetiker*, *Farrand* is non-analogous art to claims 2 and 14, notwithstanding the Examiner's assertions to the contrary.

II.F.   Rebuttal to the Examiner's Third Response

In response to the above facts, the Examiner also states that:

> In response to applicant's arguments, on page 30 last paragraph to page 31 1st paragraph, regarding the rejection of claims 2 and 14 under 35 U.S.C. 103(a) that *Farrand* is nonanalogous art, because *Farrand* is not in the field of applicant's endeavor as *Farrand* is in the field of management information bases; applicant's argument have fully been considered, but are not found to be persuasive.
> *Farrand* is analogous art because *Farrand* is in the field of applicant's endeavor; as stated by the applicant in the remarks, *Farrand* is in the field of management information bases, wherein the computer is communicating with the disk storage system (e.g. disk subsystem) for managing by configuring the disk storage system (*Farrand*, Abstract)
> 4. In response to applicant's arguments, on page 33 to page 34 1st paragraph, regarding the rejection of claims 2 and 14under 35 U.S.C. 103(a) that the examiner is viewing *Farrand* too broadly to establish the that *Farrand* is in the field of applicant's endeavor, by citing *In re Oetiker*, applicant's argument have fully been considered, but are not found to be persuasive.

> The examiner believe that the field as discussed in *In re Oetike* is much more distinct than the instant rejection, as the field disclosed by *In re Oetike* is between hose clamp and fasteners for garment. Where as in the instant application, both the applicant and *Farrand* are association with a computer system as a computer would be communicating with a disk storage system, wherein the difference is that applicant is concern with the problem associated with initialization of serial port and *Farrand* is concern with the problem associated with management information. 'Therefore, the applicant's and *Farrand's* field of endeavor is not as distinctive in comparison to hose clamp and fasteners for garment.

Office Action dated May 29, 2007, pages 2-3.

The Examiner repeats the same mistake that the Examiner made in the second response, which was discussed in Section II.E. This time, the Examiner attempts to stretch the field in which *Farrand* and claims 2 and 14 are allegedly included to "a computer system as a computer would be communicating with a disk storage system." However, as stated in Section II.E., the Examiner in *In re Oetiker* attempted a similar argument and was overruled by the Court of Appeals for the Federal Circuit.

Farrand is devoid of any disclosure that relates to serial port parameters, such as baud rate, data bits, stop bits, parity, and flow control. *Farrand* is unrelated to, let alone reasonably pertinent to, the problem to which claims 2 and 14 are directed, which is the problem of serial port initialization. Thus, under the standards of *In re Oetiker*, *Farrand* is non-analogous art to claims 2 and 14.

III.   35 U.S.C. § 103, Obviousness: Claims 4 and 16

The Examiner rejected claims 4 and 16 under 35 U.S.C. § 103 as obvious over *AAPA* in view of *Peters*, and further in view of *Harrington*, <u>Single-Use Passwords for Smart Paper Interfaces</u>, U.S. Patent 6,480,958, November 12, 2002 (hereinafter "*Harrington*"). This rejection is respectfully traversed. The Examiner states that:

> *AAPA* and *Peters* teach all the limitation of claims 3 and 15 as discussed above, but *AAPA* and *Peters* does not expressly teach the storage network system and method, further comprising wherein the storage controller has a hard-coded password for authenticating an operator of the host device before receiving the at least one serial port parameter values from the host device.
>
> *Harrington* teaches a system and a method comprising a user entering the information comprising a secret password and a personal user name or identification number and verifying the entered information is correct before granting access to the user (col. 1, 11. 30-45).
>
> *Harrington* is analogous art because *Harrington* is reasonably pertinent to the particular problem with which the applicant was concerned, providing a save mode of operation as the password is required before accessing.
>
> It would have been obvious to one of ordinary skill in this art, at the time of invention was made to include *Harrington's* entering and verification of the secret password and the personal user name or identification number into *AAPA* and *Peters'* storage network system and method. The resulting combination of the references teaches the storage network system and method further comprising the

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user/operator to enter the information comprising the secret password and the personal user name or identification number and verifying the entered information is correct before enabling the receiving of the start command send by the user/operator

The suggestion/motivation for doing so would have been for the benefit of providing security measures to ensure the receiving of the serial port parameter settings only from authorized user/operator (*Harrington*, col. 1, ll. 30-33).

Therefore, it would have been obvious to combine *Harrington* with *AAPA* and *Peters* for the benefit of providing security measures to ensure the receiving of the serial port parameter settings only from authorized user/operator to obtain the invention as specified in claims 4 and 16.

Office Action dated May 29, 2007, pages 13 and 14.

Claims 4, which is representative of claim 16, is as follows:

4.   The method of claim 3, wherein receiving at least one serial port parameter value includes:
    authenticating an operator of the host device before receiving the at least one serial port parameter value from the host device.

As an initial matter, the rejection of claims 4 and 16 relies on the false premise that *AAPA* and *Peters* teach or suggest the features of amended claim 1. However, as shown in Section I.A., *AAPA* and *Peters* fail to teach or suggest the feature of "initializing the serial port on the storage controller using the at least one serial port parameter value." In addition, *Harrington* teaches a security control system for remote computers by generating and using single-use passwords for smart paper interfaces. However, *Harrington* teaches none of the features of amended claim 1 and 13, and the Examiner does not assert otherwise. Accordingly, the proposed combination of *AAPA*, *Peters*, and *Harrington*, when considered together as a whole, does not teach or suggest all of the features of amended claims 1 and 13. Therefore, the Examiner has failed to state a *prima facie* obviousness rejection against claims 4 and 16, which depend from amended claims 1 and 13.

Also, because the Examiner attempts to combine *AAPA* and *Peters* to reject claims 4 and 16, and because claims 4 and 16 depend from amended claim 1 and 13, the same analysis applied in Section II regarding the improper combination of *AAPA* and *Peters* also applies to claims 4 and 16. Specifically, no proper reason exists to combine *AAPA* and *Peters* to achieve the invention of amended claim 1. Additionally, both *AAPA* and *Peters* teach away from amended claim 1. Accordingly, no *prima facie* obviousness rejection can be made against claims 4 and 16, against which the Examiner attempts to combine *AAPA* and *Peters*.

Additionally, no *prima facie* obviousness rejection can be made against claims 4 and 16 because *AAPA*, *Peters*, and *Harrington* fail to teach or suggest all of the claimed features of claims 4 and 16. Further, *Harrington* is non-analogous art.

III.A.   AAPA, *Peters*, and *Harrington* Fail to Teach or Suggest All of the Features of Claims 4 and 16

Additionally, the Examiner has failed to state a *prima facie* obviousness rejection because the proposed combination of references, when considered as a whole, does not teach or suggest all of the features of claims 4 and 16. The proposed combination, when considered as a whole, does not teach or suggest the claimed feature of authenticating an operator of the host device before receiving the at least one serial port parameter value from the host device. As an initial matter, the Examiner admits that "*AAPA* and *Peters* does not expressly teach the storage network system and method, further comprising wherein the storage controller has a hard-coded password for authenticating an operator of the host device before receiving the at least one serial port parameter values from the host device." Office Action dated May 29, 2007, page 13.

Additionally, *Harrington* teaches a security control system for remote computers. *Harrington* does not teach or suggest authenticating an operator of the host device before receiving the at least one serial port parameter values from the host device. The Examiner fails to indicate otherwise. Instead, the Examiner only refers to the disclosure in *Harrington* that is directed to authentication information for a user. In light of the fact that *Harrington* is devoid of specific disclosure regarding initializing serial ports, and in further light of the fact that *AAPA* and *Peters* are also devoid of this disclosure, none of the references teach or suggest all of the features of claims 4 and 16. Therefore, the proposed combination of *AAPA*, *Peters*, and *Harrington*, when considered as a whole, does not teach or suggest the feature of authenticating an operator of the host device before receiving the at least one serial port parameter value from the host device, as recited in claim 4. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claim 4 or similar claim 16.

III.B.   *Harrington* Is Non-Analogous Art

The Examiner has failed to state a *prima facie* obviousness rejection because *Harrington* is non-analogous art. In order to rely on a *Harrington* as a basis for rejection, *Harrington* must be either in the Applicant's field of endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992); *In re Deminski*, 796 F.2d 436, 442, 230 U.S.P.Q. 313, 315 (Fed. Cir. 1986).

In the case at hand *Harrington* is not in the same field of endeavor of claims 4 and 16 and *Harrington* is not reasonably pertinent to the particular problem with which Applicants were concerned. With regard to the first part of the test for analogous art, *Harrington* is not in the same field of endeavor of claims 4 and 16 because *Harrington* is in the field of security control system for remote computers. In contrast, claims 4 and 16 are in the field of setting serial port parameters. The two fields are wholly

distinct from each other because security control systems for remote computers have utterly nothing to do with setting serial port parameters in a serial port. Thus, *Harrington* fails the first test of *In re Oetiker*.

With regard to the second part of the test for analogous art, *Harrington* is not reasonably pertinent to the particular problem with which Applicants were concerned. As established above, *Harrington* is in the field of security control system for remote computers. Specifically, *Harrington* is directed to the problem of user authentication in the context of smart paper. For example, *Harrington* provides that:

> However, in systems that provide access to information, it is advantageous to implement security measures in order to limit access to only those individuals who are authorized. Often data is personal, private, and/or otherwise sensitive and it is desirable to not have it openly available. Moreover, where the remote computer or device is being instructed to perform tasks, only those individuals authorized to operate it are to be granted access. A common approach to establishing access rights is through the use of a secret password and personal user name or identification number. The password is a sequence of characters that the authorized user alone knows and enters into the computer along with their user name or identification number. The computer then checks the password against that assigned to the user to verify authorization. One problem with using this scheme in smart paper applications is that the password would be written down. This greatly jeopardizes the systems security by potentially revealing otherwise secret passwords to unauthorized individuals. As an alternative, the password may be entered via the telephone buttons or numeric keypad as part of establishing the fax link. However, this would involve the establishment of a special connection protocol in every fax machine that was to be used. Generally, it is more desirous to use arbitrary conventional fax machines. It is therefore advantageous to send the authorization code on the smart paper along with the instructions.

Harrington, column 1, lines 31-56.

In contrast, claims 4 and 16 are directed to the problem of serial port initialization. The problem addressed by *Harrington* is wholly distinct form the problem addressed by claims 4 and 16. For this reason, *Harrington* is not reasonably pertinent to the particular problem with which Applicants were concerned. Therefore, *Harrington* fails the second part of the *In re Oetiker* test for analogous art.

As established above, *Harrington* fails both tests for analogous art set forth by *In re Oetiker*. Therefore, *Harrington* is non-analogous art. For this reason, the Examiner can not use *Harrington* when fashioning an obviousness rejection against claims 4 and 16. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claims 4 and 16.

III.C. Rebuttal to the Examiner's First Response

In response to the above facts the Examiner states that:

> In responding to applicant's argument regarding independent claim 4 rejected under 35 U.S.C. 103(a) that the proposed combination of *AAPA*, *Wood* and *Harrington* does not teach all the features of the claims, because *Harrington* does not teaches or suggest initializing a serial port before receiving the at least

one serial port parameter values from the host device, as stated on page 20, 2"
paragraph to 4th paragraph. Applicant's arguments have fully been considered, but
are found not to be persuasive.

The claimed limitation as stated for claim 4 requires "... wherein
receiving at least one serial port parameter value including authenticating an
operator of the host device before receiving the at least one serial port parameter
value from the host device ..." it is unclear to the examiner where the claim
limitations require "initializing a serial port before receiving the at least one
serial port parameter values from the host device," on the contrary, it appears that
the initialization of the serial port is after the receiving the at least one serial port
parameter values from the host device, as disclosed in independent claim 1.
Therefore, it appears unclear to the examiner as to which claimed limitations the
applicant's argument is applied. As for the claimed limitation "initialization a
serial port" being taught by the combined teaching of *AAPA* and *Wood*, please
view the examiner's detailed discussion above.

Final Office Action dated December 6, 2006, page 13.

Although the Examiner no longer cites *Wood* against claims 4 and 16, Applicant's address the
portion of the Examiner's rebuttal that relates to *Harrington*, which is still used to reject claims 4 and 16.
The Examiner correctly recites the features of claim 4 as, "authenticating an operator of the host device
before receiving the at least one serial port parameter values from the host device." Applicants apologize
for the word processor error of reciting the claim feature as "initializing a serial port before..." in a
previous response, which may have prompted the Examiner's response to the original response to office
action.

However, the fact remains that *Harrington* does not teach or suggest the claimed feature of
authenticating an operator of the host device before receiving the at least one serial port parameter value
from the host device. Even if *Harrington* teaches general authenticating of operators, *Harrington* does
not teach or suggest doing so before receiving the at least one serial port parameter value form the host
device, as in claim 4. Given that *Peters* and *AAPA* also do not teach this claimed feature, the proposed
combination of these references, when considered as a whole, does not teach or suggest this claimed
feature. Accordingly, the proposed combination does not teach all of the features of claim 4. Therefore,
under the standards of *In re Royka*, the Examiner has failed to state a *prima facie* obviousness rejection
against claims 4 and 16.

III.D. Rebuttal to the Examiner's Second Response

In response to the above facts, the Examiner further states that:

In responding to applicant's argument regarding independent claim 4
rejected under 35 U.S.C. 103(a) that no teaching, suggestion, or motivation
because *AAPA*, *Wood* and *Harrington* are non-analogous art, as applicant has
cited In re *Oetiker;* as *AAPA* is directed to serial port initialization, *Wood* is
directed to the problem of speeding up spin of disk drives and *Harrington* is

directed to user authentication in the context of smart paper, therefore the references address completely distinct subject matter, as stated on page 20, last paragraph to page 21, last paragraph. Applicant's arguments have fully been considered, but are found not to be persuasive.

Please view examiner detail response above in regarding to the *AAPA* and *Wood* being analogous art. Furthermore, please note that the examiner is not relying on *Harrington's* teaching directing to the user authentication in the context of smart paper, but rather the background disclosure by *Harrington* that a user attempt to gain access to a system (e.g, computer) by entering a secret password and a personal user name or identification number, and after proper verification that the entered information are correct, the user is granted access (*Harrington*, col. 1, ll. 30-45).

By combining *Harrington's* user authentication into *AAPA* and *Wood's* storage network system and method, such as in the storage controller; the resulting combination teaches the operator to entering the secret password and the personal user name or identification number, and after proper verification that the entered information are correct, the operator is granted access to the RAID system as the at least one serial port parameter values is received from the host computer.

The motivation for the combination of *Harrington* with *AAPA* and *Wood* is to provide security measures to ensure granting of access to only those individuals who are authorized (*Harrington*, col. 1, ll. 30-33), which is also taught by *Harrington's* background disclosure.

Final Office Action dated December 6, 2006, pages 13-14.

Applicants first rebut the Examiner's assertion regarding the "general" teachings of *Harrington*. The Examiner asserts that the Examiner relies on, "the background disclosure by *Harrington* that a user attempt to gain access to a system (e.g, computer) by entering a secret password and a personal user name or identification number, and after proper verification that the entered information are correct, the user is granted access." However, the Examiner is not entitled to rely on the general teachings of *Harrington*. See *In re Royka*. Instead, the Examiner must demonstrate how *Harrington*, together with *AAPA* and *Peters*, teaches the entire and specific claimed feature of authenticating an operator of the host device before receiving the at least one serial port parameter value from the host device. The Examiner has not done so. Therefore, the Examiner has failed to state a *prima facie* obviousness rejection.

Furthermore, even assuming, *arguendo*, that the Examiner were to rely on *Peters* and *AAPA* to teach the "before receiving the at least one serial port parameter value from the host device" portion of claim 4, no reason exists to pick and choose some feature of the background art from a reference unrelated to the claims or to *Peters* or *AAPA*, such as *Harrington*. Therefore, again, the Examiner failed to state a *prima facie* obviousness rejection.

III.E.   Rebuttal to the Examiner's Third Response

In response to the above facts, the Examiner further states that:

In response to applicant's arguments, on page 36 last paragraph to page 37, regarding the rejection of claims 4 and 16 under 35 U.S.C. 103(a) that *Harrington* is nonanalogous art, because *Harrington* is not reasonable pertinent to the particular problem with which applicant were concerned; applicant's arguments have fully been considered, but are not found to be persuasive.

It appears to the examiner that the purpose that the applicant is implementing the claimed "authenticating" is to ensure a safe mode of operation (Specification, page 7, 11.1 8-22), therefore, *Harrington 's* secret password and personal user name that needed to be entered before accessing the computer would be pertinent to the particular problem for providing a safe mode of operation, as the user must be authenticated by first entering the secret password and personal user name before gaining access.

Office Action dated May 29, 2007, page 4.

However, in construing the problem to which *Harrington* is directed, the Examiner ignores not only the remainder of *Harrington 's* disclosure, but also the remainder of the paragraph from which the Examiner conjures the alleged problem to which *Harrington* is directed. Specifically, *Harrington* provides as follows:

> However, in systems that provide access to information, it is advantageous to implement security measures in order to limit access to only those individuals who are authorized. Often data is personal, private, and/or otherwise sensitive and it is desirable to not have it openly available. Moreover, where the remote computer or device is being instructed to perform tasks, only those individuals authorized to operate it are to be granted access. A common approach to establishing access rights is through the use of a secret password and personal user name or identification number. The password is a sequence of characters that the authorized user alone knows and enters into the computer along with their user name or identification number. The computer then checks the password against that assigned to the user to verify authorization. One problem with using this scheme in smart paper applications is that the password would be written down. This greatly jeopardizes the systems security by potentially revealing otherwise secret passwords to unauthorized individuals. As an alternative, the password may be entered via the telephone buttons or numeric keypad as part of establishing the fax link. However, this would involve the establishment of a special connection protocol in every fax machine that was to be used. Generally, it is more desirous to use arbitrary conventional fax machines. It is therefore advantageous to send the authorization code on the smart paper along with the instructions.

Harrington, column 1, lines 30 – 56 (emphasis added).

As shown in the quoted paragraph of *Harrington*, *Harrington* is not directed merely to the authentication of operators of remote device, but the authentication of operators of remote device using smart paper, which may be transmitted, for example, via fax machines. The problem to which *Harrington* is directed is also indicated by *Harrington 's* title, which is "Single-Use Passwords for Smart Paper Interfaces." Thus, because claims 4 and 16 are directed to the problem of serial port initialization, and because *Harrington* is directed to the wholly distinct problem of user authentication in the context of

smart paper, *Harrington* is not reasonably pertinent to the particular problem with which Applicants were concerned. Thus, under the standards of *In re Oetiker, Harrington* is non-analogous art to claims 4 and 16.

In response to the above facts regarding the failure of *Harrington* to teach or suggest the feature of authenticating an operator of the host device before receiving the at least one serial port parameter values from the host device, the Examiner further states that:

> In response to applicant's arguments, on page 38 last paragraph, regarding the rejection of claims 4 and 16 under 35 U.S.C. 103(a) that *Harrington* do not teach or suggest doing so (e.g. authenticating) before receiving the at least one serial port parameter value from the host device; applicant's arguments have fully been considered, but are not found to be persuasive.
> By combining Harrington into *AAPA* as modified, it would be obvious that the entering of the secret password and personal user name would be done before receiving the at least one serial port parameter value from the host device, because if the secret password and personal user name were to be entered afterwards, the secret password and personal user name would not be able to provide the safe mode of operation as any user could have been able to gain access without authentication.

Office Action dated May 29, 2007, page 4.

In order to state a *prima facie* obviousness rejection against claims 4 and 16, the Examiner must show that the cited references teach or suggest all of the features of claims 4 and 16. However, instead of demonstrating how *Harrington, AAPA,* and *Peters* teach or suggest the feature of authenticating an operator of the host device before receiving the at least one serial port parameter value from the host device, the Examiner attempts to salvage the rejection by stating that "it would be obvious" to enter a secret password and personal user name before receiving the at least one serial port parameter value from the host device. Because the Examiner eschews showing that the references teach or suggest the claimed feature, and because the Examiner states only that "it would be obvious" that *Harrington 's* authentication would occur before receiving the at least one serial port parameter value from the host device, the Examiner implicitly admits that the references themselves do not teach or suggest the feature of authenticating an operator of the host device before receiving the at least one serial port parameter value from the host device.

In fact, *Harrington* nowhere relates operator authentication to serial port parameter values. For example, *Harrington* provides as follows:

> However, in systems that provide access to information, it is advantageous to implement security measures in order to limit access to only those individuals who are authorized. Often data is personal, private, and/or otherwise sensitive and it is desirable to not have it openly available. Moreover, where the remote computer or device is being instructed to perform tasks, only those individuals authorized to operate it are to be granted access. A common approach to

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> establishing access rights is through the use of a secret password and personal user name or identification number. The password is a sequence of characters that the authorized user alone knows and enters into the computer along with their user name or identification number. The computer then checks the password against that assigned to the user to verify authorization. One problem with using this scheme in smart paper applications is that the password would be written down. This greatly jeopardizes the systems security by potentially revealing otherwise secret passwords to unauthorized individuals. As an alternative, the password may be entered via the telephone buttons or numeric keypad as part of establishing the fax link. However, this would involve the establishment of a special connection protocol in every fax machine that was to be used. Generally, it is more desirous to use arbitrary conventional fax machines. It is therefore advantageous to send the authorization code on the smart paper along with the instructions.

Harrington, column 1, lines 30 – 56.

As exemplified by the quoted portion, *Harrington* nowhere relates operator authentication to serial ports or serial port parameter values. Thus, even assuming, *arguendo*, that *Harrington* teaches or suggests authenticating an operator of the host device, *Harrington* still fails to teach or suggest that the authenticating bears any temporal relation to the receipt of serial port parameter values, let alone that the authenticating occurs before receiving the at least one serial port parameter value from the host device. Thus, the references fail to teach or suggest all of the features of claims 4 and 16. Accordingly, no *prima facie* obviousness rejection has been stated against claims 4 and 16.

IV.   35 U.S.C. § 103, Obviousness; Claims 6 and 18

The Examiner rejected claims 6 and 18 under 35 U.S.C. § 103 as obvious over *AAPA* in view of *Peters*, and further in view of *Walter et al.*, Baud Rate Detection in Serial Data Transmission, U.S. Patent 6,847,615, January 25, 2005 (hereinafter "*Walter*"). This rejection is respectfully traversed. The Examiner states that:

> *AAPA* and *Peters* teach all the limitations of claims 1 and 13 as discussed above, where both further teach the storage network system and method, comprising:
> wherein the set of serial port parameters includes baud rate (*Peters*, col. 2, ll. 11-12);
> the external device (e.g. laptop computer or maintenance device) connected to the storage controller (e.g. disk/RAID controller) through the serial port (Specification, page 2, ll. 14-15); and
> wherein the user sets the serial port baud rate by utilizing a break key sequence (*AAPA*, Specification, page 2, l. 28 to page 3, l. 1).
> *AAPA* and *Peters* does not teach the storage network system and method, comprising wherein receiving at least one serial port parameter value includes the external device performing an adaptive baud rate negotiation between the storage controller and the external device.
> *Walter* teaches a system and a method for baud rate detection for serial data comprising the negotiating the baud rate of the transferring data by utilizing

the function of setting a receiving device (storage device) to a correct baud rate for receiving data (col. 2, 11. 8-15), wherein the data received comprises of a predetermined data word, such as one of the character 'A' or 'a', and the next character in the serial data transmission may be 'T' or 't' (col. 2, 11.49-52 and col. 6, 11. 43-49).

     Walter is analogous art because then *Walter* is reasonably pertinent to the particular problem with which the applicant was concerned which determination of the baud rate for serial data transmission.

     It would have been obvious to one of ordinary skill in this art, at the time of invention was made to include *Walter's* setting of correct baud rate into *AAPA* and *Peters'* storage device. The resulting combination of the references teaches the storage network system and method further comprising setting the correct baud rate by receiving data including the break sequence, therefore implementing the adaptive baud rate negotiation between the storage controller and the external device based on the received break key sequence.

     The suggestion/motivation for doing so would have been for the benefit of providing the automatic determination of baud rate for the serial data transmission (*Walter*, Abstract and col. 2, 11. 1-2).

     Therefore, it would have been obvious to combine *Walter* with *AAPA* and *Peters* for the benefit of providing the automatic determination of baud rate for the serial data transmission to obtain the invention as specified in claims 6 and 18.

Office Action dated May 29, 2007, pages 15 and 16.

     Claim 6, which is representative of claim 18, is as follows:

     6.   The method of claim 1, wherein the set of serial port parameters includes baud rate and wherein receiving at least one serial port parameter value includes performing an adaptive baud rate negotiation between the storage controller and the external device connected to the storage controller through the serial port.

     As an initial matter, the rejection of claims 6 and 18 relies on the false premise that *AAPA* and *Peters* teach or suggest the features of amended claim 1. However, as shown in Section I.A., *AAPA* and *Peters* fail to teach or suggest the feature of initializing the serial port on the storage controller using the at least one serial port parameter value. In addition, *Walter* discloses a method for determining and setting a baud rate of a serial data transmission. However, *Walter* teaches none of the features of amended claims 1 and 13, and the Examiner does not assert otherwise. Accordingly, the proposed combination of *AAPA*, *Peters*, and *Walter*, when considered together as a whole, does not teach or suggest all of the features of amended claims 1 and 13. Therefore, the Examiner has failed to state a *prima facie* obviousness rejection against claims 6 and 18, which depend from amended claims 1 and 13.

     Also, because the Examiner attempts to combine *AAPA* and *Peters* to reject claims 6 and 18, and because claims 6 and 18 depend from amended claims 1 and 13, the same analysis applied in Section II regarding the improper combination of *AAPA* and *Peters* also applies to claims 6 and 18. Specifically, no proper reason exists to combine *AAPA* and *Peters* to achieve the invention of amended claim 1. Additionally, both *AAPA* and *Peters* teach away from amended claim 1. Accordingly, no *prima facie*

obviousness rejection can be made against claims 6 and 18, against which the Examiner attempts to combine *AAPA* and *Peters*. Additionally, no *prima facie* obviousness rejection can be made against claims 6 and 18 because *AAPA*, *Peters*, and *Walter* fail to teach or suggest all of the claimed features of claims 6 and 18.

IV.A.   *AAPA*, *Peters*, and *Walter* Fail to Teach or Suggest All of the Features of Claims 6 and 18

Additionally, the Examiner has failed to state a *prima facie* obviousness rejection because the proposed combination of references, when considered as a whole, does not teach or suggest all of the features of claims 6 and 18. The proposed combination, when considered as a whole, does not teach or suggest the claimed feature of performing an adaptive baud rate negotiation between the storage controller and an external device connected to the storage controller through the serial port, as claimed. *AAPA* and *Peters* do not teach or suggest this claimed feature. Additionally, *Walter* is devoid of disclosure in this regard.

Walter does teach a method for determining and setting a baud rate of a serial data transmission. However, *Walter* teaches a method that is entirely distinct from the claimed feature of adaptive baud rate negotiation. Specifically, *Walter* teaches identifying the baud rate, checking to see if the identified baud rate is correct, setting a new baud rate if the identified baud rate is not correct, checking the new baud rate, and then iteratively setting baud rates and checking baud rates until the correct baud rate is achieved. *Walter* describes the process as "autobauding." For example, *Walter* provides for:

> A method for automatically determining the baud rate of a serial data transmission comprises the steps of setting a receiving device to a first baud rate, processing (65) a first data word received by said receiving device and possibly further information to determine said baud rate of said data transmission, possibly setting (68) said receiving device to a second baud rate in order to enable said receiving device to find the beginning of a subsequent data word in said serial data transmission, and possibly setting (74) said receiving device to said determined baud rate. A corresponding apparatus and a mobile telephone each employs this method. The invention provides an autobauding function which causes little expense in terms of hardware and processing time, and which will correctly synchronize with the serial data transmission even if the transmitted data words immediately follow each other.

Walter, Abstract.

In contrast, the invention of claim 6 requires "adaptive baud rate negotiation." This term is defined in the specification as follows:

> The present invention also provides an adaptive baud rate negotiation mechanism using the Universal Asynchronous Receiver Transmitter (UART) registers in the serial port. The adaptive baud rate negotiation is based on the return characters received from a break character from the serial console. The controller may have a UART chip on board that contains programmable baud rate generator that is capable of taking any clock input and dividing it by a divisor from 2 to 65,535. The output frequency of the baud rate generator is sixteen times the baud [divisor # =

(frequency input) / (baud rate • 16)]. Two 8-bit latches store the divisor in a 16-bit binary format. The divisor latches must be loaded during initialization to ensure proper baud rate selection and operation of the baud generator. Upon loading either of the divisor latches, a 16-bit baud counter is immediately loaded.

The adaptive baud rate negotiation mechanism sets a default baud rate, such as 9600 bps, during controller boot up and waits for a return character to be received on an external device connected to the serial port after sending a <BREAK> from the serial console. The time taken to transmit a bit depends on the baud rate set on the UART. In the time for transmitting a single bit using 9600 bps, two bits may be transmitted if 19,200 bps is used. Hence, starting an arbitrary timer as soon as the <BREAK> is transmitted and terminating the timer upon receiving a return character from the terminal can compute the time taken to receive the character on the console.

The adaptive baud rate negotiation mechanism waits for a start bit (falling edge) on the serial input pin and then starts the timer. At every subsequent rising edge of the serial data, the timer value is captured and saved. When the timer expires, the last captured value will indicate the duration of the serial character from the start bit to the last zero-to-one transition.

Applicant's specification, page 8, lines 4-14.

Thus, "adaptive baud rate negotiation" uses time values and break characters in concert with the Universal Asynchronous Receiver Transmitter to establish baud rate negotiation. This technique is entirely distinct from the technique shown in *Walter*. The techniques are so different that no one of ordinary skill would consider *Walter's* technique of "autobauding" as teaching or suggesting the claimed technique of "adaptive baud rate negotiation." Accordingly, none of the references teach the claimed feature of "adaptive baud rate negotiation." Therefore, the proposed combination of *AAPA*, *Peters*, and *Walter*, when considered as a whole, does not teach or suggest this claimed feature as recited in claims 6 and 18. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claims 6 or 18.

IV.B.   Rebuttal to the Examiner's First Response

In response to the above facts the Examiner states that:

> In responding to applicant's argument regarding independent claim 6 rejected under 35 U.S.C. 103(a) that the combined teaching of *AAPA*, *Wood* and *Walter* do not teach the claimed feature of "performing an adaptive bald rate negotiation between the storage controller and an external device connected to the storage controller through the serial port," because *Walter* does not teach "adaptive baud rate negotiation," such that the "adaptive baud rate negotiation" uses time value and break characters in concert with the UART to establish baud rate negotiation, as stated on page 23, 3rd paragraph to page 25, 1st paragraph. Applicant's arguments have fully been considered, but are found not to be persuasive.
>
> Please note that the features upon which applicant relies (i.e., using time value and break characters in concert with the UART to establish baud rate negotiation) are not recited in the rejected claims). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 11 81, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, the setting of the baud rate would be adaptively negotiated, as stated in the applicant's remark: "

"identifying a baud rate,
checking to see if the identified baud rate is correct,
setting a new baud rate if the identified baud rate is not correct,
checking the new baud rate, and
then iteratively setting a baud rate and checking baud rate until the correct baud rate is achieved." (applicant's remarks, p. 23, last paragraph)
as the correct baud rate is adaptively negotiated through the iteration of setting and checking.

Final Office Action dated December 6, 2006, pages 15-16.

Although the Examiner no longer cites *Wood* against claims 6 and 18, Applicant's address the portion of the Examiner's rebuttal that relates to *Walter*, which is still used to reject claims 6 and 18. The Examiner first asserts that the features argued by Applicants are not recited in the claims. However, the Examiner is incorrect. The precise claim feature recited in claim 6 is, "wherein receiving at least one serial port parameter value includes performing an adaptive baud rate negotiation between the storage controller and an external device connected to the storage controller through the serial port" (emphasis added).

An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" and, if done, must "'set out his uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the art notice of the change" in meaning) (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992)). Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings"). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998).

In the case at hand, the term "adaptive baud rate negotiation" is not a common term of art. For example, a search on Google revealed one hit when searching for this term. This one hit refers to Applicant's own patent application publication. Thus, the term "adaptive baud rate negotiation" is a unique term defined in this patent application.

As shown above, the claimed term "adaptive baud rate negotiation" is sufficiently clear in the specification such that any departure from common usage would be understood by a person of experience in the field of the invention, under the standards of *Multiform Dessicant*. Additionally, the term "adaptive baud rate negotiation" is set forth in the specification with reasonable clarity, deliberateness, and precision and sets out the uncommon definition a manner within the application's disclosure so as to give one of ordinary skill in the art notice of the meaning, under the standards of *In re Paulsen*. Therefore, the definition of the claimed term, "adaptive baud rate negotiation" is a part of the features of claims 6 and 18, notwithstanding the Examiner's protestations to the contrary.

Regarding the Examiner's statements that the prior art teaches adaptive baud rate negotiation, the Examiner is again manifestly incorrect. For example, none of the Examiner's statements address the fact that, "adaptive baud rate negotiation is based on the return characters received from a break character from the serial console," as provided in the specification at page 8. As shown above, because the term "adaptive baud rate negotiation" necessarily includes the definition presented in the specification, the Examiner is not entitled to ignore this fact. In the case at hand, the Examiner has not shown how the references teach this claimed feature of "adaptive baud rate negotiation." The Examiner cannot establish that the prior art teaches or suggests this claimed feature because the prior art is devoid of disclosure in this regard. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claims 6 and 18.

IV.C. Rebuttal to the Examiner's Second Response

In response to the above facts the Examiner states that:

> In response to applicant's arguments, on page 41 to page 45, regarding the rejection of claim 6 under 35 U.S.C. 103(a) that the combination of references do not teach the claimed "adaptive baud rate negotiation"; applicant's arguments have fully been considered, but are not found to be persuasive.
>
> In view of applicant's disclosure and also the specification, there appears no specific disclosure that the claimed "adaptive baud rate negotiation is defied as . . . "; furthermore, if the "adaptive baud rate negotiation is based on the return character received from a break character from the serial console," (Remarks, page 45, 3rd paragraph) then *AAPA* teaches receiving the break character invoked on the serial console (Specification, page 2, 11. 28-29), and *Walter* teaches adaptively determining the correct baud rate by transferring and receiving characters such as 'A' or 'a' (col. 2, 11. 49- 52 and col. 6,11. 43-49); therefore, the resulting combination of the references would teach adaptively determining the correct baud rate (e.g. adaptive baud rate negotiation) by transferring and receiving the break character from the serial console.

Office Action dated May 29, 2007, page 5.

The Examiner first implies that the Applicant's failure to use the phase "is defined as" precludes the Applicant from acting as his or her own lexicographer. However, the MPEP includes no such

requirement. Specifically, the portion of the MPEP entitled "Applicant May be Own Lexicographer," is as follows:

> An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" and, if done, must "'set out his uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the art notice of the change" in meaning) (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992)). Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings"). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) and MPEP § 2173.05(a). The specification should also be relied on for more than just explicit lexicography or clear disavowal of claim scope to determine the meaning of a claim term when applicant acts as his or her own lexicographer; the meaning of a particular claim term may be defined by implication, that is, according to the usage of the term in >the< context in the specification. See *Phillips v. AWH Corp.*, *>415 F.3d 1303<, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*); and *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996). Compare *Merck & Co., Inc., v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1370, 73 USPQ2d 1641, 1646 (Fed. Cir. 2005), where the court held that patentee failed to redefine the ordinary meaning of "about" to mean "exactly" in clear enough terms to justify the counterintuitive definition of "about." ("When a patentee acts as his own lexicographer in redefining the meaning of particular claim terms away from their ordinary meaning, he must clearly express that intent in the written description.").

MPEP section 2111.01.

The quoted portion of the MPEP nowhere requires any magic phrases, such as "defined as," in order for the Applicant to act as his or her own lexicographer. Thus, the Applicant has properly acted as his or her own lexicographer in defining "adaptive baud rate negotiation."

The Examiner also misconstrues the definition of adaptive baud rate negotiation provided by the Applicants. Specifically, the Examiner chooses to address only one aspect of adaptive baud rate negotiation. Namely, the Examiner addresses only the aspect of adaptive baud rate negotiation that is based on the return character received from a break character from the serial console. However, as shown above, adaptive baud rate negotiation uses <u>time values</u> and break characters <u>in concert with the Universal</u>
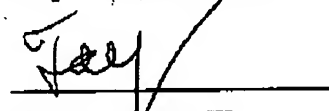
Asynchronous Receiver Transmitter to establish baud rate negotiation. Thus, the Examiner fails to show that *Walter* teaches or suggests the claimed feature. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claims 6 and 18.

V.   Conclusion

The subject application is patentable over the cited references and should now be in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: August 29, 2007

Respectfully submitted,

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